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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,048	02/08/2002	John Scott McDaniel	5415	3640

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EXAMINER

SALVATORE, LYNDIA

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,048

Applicant(s)

MCDANIEL ET AL.

Examiner

Lynda M Salvatore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-24 and 28-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 17-24 and 28-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment and accompanying remarks filed 02/23/04 have been fully considered and entered. Claims 1-16 and 25-27 have been canceled, claims 17-24 and 28-31 have been amended and claims 32-34 have been added as requested. Applicant's cancellation of claim 1 renders moot the claim objection as set forth in section 1 of the last Office Action. Applicant's cancellation of claim 1 and amendment to claim 24 renders moot the 35 U.S.C. 112, first and second paragraph rejections set forth in sections 2-6 of the last Office Action. Applicant's cancellation of claims 1-16 renders moot the rejection under 35 U.S.C. 102(b) as being anticipated by Groten et al., US 5,899,785 as set forth in section 8 of the last Office Action. Despite this advance in prosecution however, Applicant's amendments are not found to patently distinguish the claims over the prior art of record and Applicant's arguments are not found persuasive of patentability for reasons set forth herein below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 17 and 24 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for providing a fabric which has been subjected to an acid/base treatment such that the conjugate fibers are split to form first and second filaments, wherein the second filament structure is eroded, it does not reasonably provide enablement for mechanically separating the filaments. It is the position of the Examiner that mechanical

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separation requires processes which supply a sufficient amount of energy to effect separation.

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 17 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 17 and 24 are indefinite because it is unclear to the Examiner how mechanically separating the fibers into first and second filaments would provide the recited absorption capacity/enhanced hydrophilic limitations. Claims 18-23 and 28-34 are further rejected for their dependency on claims 17 and 24.

Response to Arguments

Claim Rejections - 35 USC § 102/103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 17-23 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Groten et al., US 5,899,785.

Applicant amended claim 17 to recite that the conjugate filaments have been mechanically separated along their filament lengths and argues that the prior art reference fails to

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teach the claimed absorption capacity limitations. Applicant refers to Table 1 of the specification, which illustrates comparative examples of treated vs. untreated fabrics. Applicant asserts that the absorbency of the treated fabrics is superior to the untreated fabrics. In response, while it may be true that Applicant's treated fabrics exhibit superior absorption characteristics, it is respectfully pointed out that the limitations which provide for said characteristics are not claimed. Applicant merely claims a fabric comprising mechanically separated fibers having a desired absorption capacity. It is noted that mechanical separation is inconsistent with Applicant's specification for providing the claimed absorbency/hydrophilic properties as Applicant's specification attributes said properties to the acid/base treatment. In addition, the *mechanical* limitation constitutes a process limitation. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claims is the same as or an obvious variant from a product in the prior art, the claim is unpatentable even though the prior art product was made by a different process. *In re Thorpe*, 227 USPQ 964,966 (Fed. Cir. 1985) The burden is shifted to Applicant to show an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,292 (Fed Cir. 1983) With regard to the inherency of the absorption capacity, the Examiner maintains the previously set forth arguments in the last Office Action. To reiterate, the patent issued to Groten et al., teaches a non-woven fabric comprising very fine continuous filaments of separable composite filaments (Abstract). The composite filaments forming the elementary filaments may comprise a polyester/polyamide combinations such polyethylene terephthalate and polyamide 6 (Column 1, 63-67 and Figures 1-3).

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Although, Groten et al., fails to explicitly state the absorption capacity of the non-woven fabric, it is reasonable to presume that said absorption property is inherent to the invention of Groten et al. Support for said presumption is found in the use of like materials (i.e., polyamide 6 and PET) and the use of like processes such as separating composite filaments into elementary filaments, which would result in the claimed absorption property. The burden is upon the Applicant to evidence otherwise. *In re Fitzgerald* 205 USPQ 594

In addition, the presently claimed absorption properties would obviously have been present once the Groten et al., product is provided. *In re Best*, 195 USPQ 433

If Applicant maintains a lack of inherency with respect to the absorption capacity property, then the claims must be incomplete. Stated differently, as presently recited the claims do not recite the chemical and/or structural limitations, which provide for said property.

9. Claims 24-31 stand rejected and newly added claims 32-34 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Park et al., US 4,460,649.

Applicant amended claim 24 to recite separated by mechanical means and argues that Park et al., fails to teach a non-woven fabric having hydrolyzed ester groups and an eroded polyamide filament structure. These arguments are not found persuasive. With respect to the hydrolyzed ester groups, the Examiner asserts that said groups would be present once the fabric is treated with the basic solution as taught by Park et al. The basic solution would cleave the ester groups, thus producing the "hydrolyzed" ester groups. With respect the eroded polyamide filament structure, Park et al., also teaches treating the fabric comprising the claimed conjugate filaments with an acid solution, which would inherently erode the polyamide filament structure.

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Applicant has failed to set forth limitations, which would patently distinguish the instant invention over the prior art article. Thus, absent such limitations the Examiner maintains that Park et al., teaches all of the limitations set forth in the final product structure. To reiterate, the patent issued to Park et al., teaches a conjugate fiber comprising polyamide and polyester having an island-in-sea configuration (Column 1, 36-42). Park et al., teaches separating the outer components from the inner components by treating the fabric with acid and alkali chemicals (Column 1, 64-Column 3, 10). The resulting microfibers are suitable for weaving or knitting into a fabric (Column 2, 13-15).

Although, Park et al., fails to explicitly state the enhanced hydrophilic characteristics, it is reasonable to presume that said absorption property is inherent to the invention of Park et al. Support for said presumption is found in the use of like materials (i.e., polyamide and polyester) and the use of like processes such as treatment with an acid and base chemicals, which would result in the claimed absorption property. Especially since the specification states said characteristics result from of an acid/base treatment. The burden is upon the Applicant to evidence otherwise. *In re Fitzgerald* 205 USPQ 594

In addition, the presently claimed absorption properties would obviously have been present once the Park et al., product is provided. *In re Best*, 195 USPQ 433

Additionally, the *mechanical* limitation constitutes a process limitation. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claims is the same as or an obvious variant from a product in the prior art, the claim is unpatentable even though the prior art

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product was made by a different process. *In re Thorpe*, 227 USPQ 964,966 (Fed. Cir. 1985) The burden is shifted to Applicant to show an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,292 (Fed Cir. 1983)

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M. Salvatore whose telephone number is 571-272-1482. The examiner can normally be reached on M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1482. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 21, 2004

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